

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

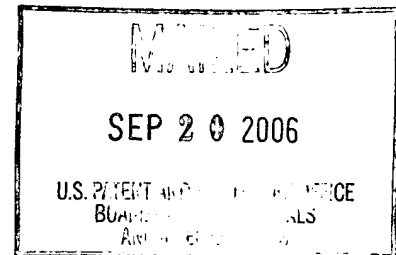
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JACQUELYN ANNETTE MARTINO,
DAMIAN M. LYONS, and KAREN I. TROVATO

Appeal No. 2006-0909
Application No. 09/282,320

ON BRIEF



Before RUGGIERO, BARRY, and SAADAT, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

A patent examiner rejected claims 1-20. The appellants appeal therefrom under 35 U.S.C. § 134(a). We affirm.

I. BACKGROUND

The invention at issue on appeal relates to computer vision. The use of cameras in computer systems, which the appellants call "computer vision," is expanding. Video conferencing, "live feeds," and the like are common applications using computer vision. (Spec., p. 1, ll. 5-10.)

A typical computer vision application is often operated using a fixed position camera, without a dedicated camera operator. Without such an operator, keeping the

targeted person in view of the camera can be difficult. Another difficulty associated with an unattended camera is the lack of feedback to the person as to how he appears to the camera. (*Id.* at ll. 17-22.)

Accordingly, the appellants' invention integrates a camera and a mirror such that the mirror's field of reflection corresponds substantially to the camera's field of view. If a targeted person can see his reflection in the mirror, he is assured that a substantially similar image is being seen by the camera. (*Id.*, p. 2, ll. 18-22.)

A further understanding of the invention can be achieved by reading the following claim.

18. A method of framing an image of an object within a camera image comprising the steps of:

aligning a mirror having a two-way transparent center area having a field of view that substantially corresponds to a field of view of the camera, and

attaching the mirror to an external surface of the camera so as to provide a mirror image that is representative of the camera image except for the transparent solid center area, and

adjusting a position of the object in dependence upon the mirror image and thereby frame the image of the object in the camera image.

Claims 1-2, 4-7, 9-15, and 18-20 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,337,175 ("Kamaya"); U.S. Patent No. 5,940,229 ("Baumgarten"); and U.S. Patent No. 5,394,198 ("Janow "). Claim 3 stands rejected under §103(a) over Kamaya; Baumgarten; Janow; and U.S. Patent No. 5,532,737 ("Braun"). Claim 8 stands rejected under §103(a) over Kamaya; Baumgarten; Janow; and U.S. Patent No. 6,079,862 ("Kawashima"). Claims 16 and 17 stand rejected under §103(a) over Kamaya; Baumgarten; Janow; and U.S. Patent No. 5,943,603 ("Parulski").

II. OPINION

Our opinion offers some observations and then addresses the rejections.

A. OBSERVATIONS

"[C]ompliance with the 'written description' requirement of §112 is a question of fact. . . ." *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) (citing *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989); *Utter v. Hiraga*, 845 F.2d 993, 998, 6 USPQ2d 1709, 1714 (Fed. Cir. 1988)). "Although [the applicant] does not have to describe exactly the subject matter claimed, . . . the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." 935 F.2d at 1563, 19 USPQ2d at 1116 (quoting *Gosteli*, 872 F.2d at 1012, 10 USPQ2d at 1618). "[T]he test for

sufficiency of support . . . is whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'" *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)). "Application sufficiency under §112, first paragraph, must be judged as of the filing date [of the application]." *Vas-Cath*, 935 F.2d at 1566, 19 USPQ2d at 1119 (citing *United States Steel Corp. v. Phillips Petroleum Co.*, 865 F.2d 1247, 1251, 9 USPQ2d 1461, 1464 (Fed. Cir. 1989)). Because "[t]he applicant is in the best position to explain his invention," *Hyatt v. Dudas*, No. 03-108 (EGS), slip op. at 26 (D.D.C. 2005), moreover, the "[a]pplicant should . . . specifically point out the support for any amendments made to the disclosure." M.P.E.P. § 2163.06.

Here, neither the limitation that the mirror of independent claims 1, 11, and 15 is "movably arranged at an angle to the camera" nor the limitation that the mirror of independent claims 1, 11, 15, and 18 features "a field of view" (emphasis added) appeared in the original claims. The former limitation was added by an amendment filed on October 23, 2002, (Paper No. 15 at 1); the latter limitation was added by an amendment filed on November 3, 2003. (Paper No. 24 at 2.) In the earlier amendment, although the appellants asserted that "[c]laims 1, 11, and 15 have been

amended to clarify the claimed invention," (Paper No. 15 at 3), no attempt was made to point out any support for the adding the limitation that the claimed mirror is "movably arranged at an angle to the camera."

In the latter amendment, the appellants noted that "[c]laims 1, 11, 15 and 18 have been amended to clarify that the field of view of the mirror substantially corresponds to the field of view of the camera," (Paper No. 24 at 8), and alleged that "[s]upport for the amendment is clearly provided throughout the specification, for example, Abstract at lines 5-6 and shown in Fig. 1." (*Id.*) The field of **view** mentioned in the abstract and shown in the Figure, however, are that of "the camera." (Abs., ll. 6-7.) Rather than a field of view of the mirror, the abstract and Figure 1 disclose that the mirror features "a field of **reflection**." (*id.* at l. 6 (emphasis added).) The relation between the "field of *view*" of the mirror added to independent claims 1, 11, 15 and 18 and the "field of reflection" of the mirror recited in some of the dependent claims (e.g., claims 2, 13, and 19), moreover, is unclear.

In an *ex parte* appeal, "the Board is basically a board of review — we review . . . rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (Bd.Pat.App. & Int. 2001). Consequently, we leave the issue of whether the original disclosure of the appellants' application reasonably conveys to the artisan that the

appellants had possession, at the time of the invention, of either of the aforementioned limitations to the examiner and the appellants.

Furthermore, a claim is indefinite "where the language 'said lever' appears in a dependent claim where no such 'lever' has been previously recited in a parent claim to that dependent claim" *Ex parte Moelands*, 3 USPQ2d 1474, 1476 (Bd.Pat.App. & Int. 1987).

Here, although claim 18 includes the language "**the** transparent **solid** center area," (emphasis added), no such transparent **solid** center area has been previously recited therein. Like the possession issues, *supra*, we leave the issue of whether the claims lack antecedent basis to the examiner and the appellants.

B. REJECTIONS

"[T]o assure separate review by the Board of individual claims within each group of claims subject to a common ground of rejection, an appellant's brief to the Board must contain a clear statement for each rejection: (a) asserting that the patentability of claims within the group of claims subject to this rejection do not stand or fall together, and (b) identifying which individual claim or claims within the group are separately patentable and the reasons why the examiner's rejection should not be sustained."

In re McDaniel, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) (citing 37 C.F.R. §1.192(c)(7)). "Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable." 37 C.F.R. § 1.192(c)(7) (2004).¹ "If the brief fails to meet either requirement, the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim." *McDaniel*, 293 F.3d at 1383, 63 USPQ2d at 1465.

Here, the appellants stipulate that claims 1, 2, 4-7, 9-15, and 18-20 "fall together." (Appeal Br. at 5.) We select claim 18 from the group as representative of the claims therein.

"With this representation in mind, rather than reiterate the positions of the examiner or the appellants *in toto*, we focus on the two points of contention

¹We cite to the version of the Code of Federal Regulations in effect at the time of the appeal brief.

therebetween," *Ex parte Dang*, No. 2003-0506, 2004 WL 1665541, at *2 (Bd.Pat.App & Int. 2006):

- mirror attached to camera
- transparent area.

1. Mirror Attached to Camera

The examiner finds, "Baumgarten clearly teaches an image generating device (4, figure 5) for quickly and easily inspecting users' own appearance including a framing mirror (24, figure 5) attached to an exterior of the camera (70, figure 5) so that the mirror is movably arranged at an angle to the camera (col. 3 lines 29-51) as claimed, wherein the mirror comprises a two-way transparent center area, i.e., a hole (80, figure 5) located at the center area of the mirror (40, figure 5), to permit the camera to capture image. . . ." (Examiner's Answer at 15-16.) The appellants argue, "Baumgarten teaches that the mirror (24) may be adjusted horizontally and vertically. But fails to show how the mirror is movably arranged at an angle to the camera, as is recited in the claims. In fact, Baumgarten is silent with regard to the mirror movably arranged with regard to the camera." (Supp. Reply Br. at 6.)

"In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the representative claim at issue to its scope. Second, we determine

whether the construed claim would have been obvious." *Ex Parte Massingill*, No. 2003-0506, 2004 WL 1646421, at *2 (Bd.Pat.App & Int. May 20, 2004).

a. Claim Construction

"Analysis begins with a key legal question — *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "the PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324, 72 USPQ2d 1209, 1211 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Here, claim 18 does not recite that a mirror be movably arranged at an angle to the camera. The representative claim merely recites in pertinent part the following limitations: "attaching the mirror to an external surface of the camera" Giving claim 18 its broadest, reasonable construction, the limitations merely require attaching a mirror to a camera.²

²Even if the representative claim did recite the limitation that its mirror is "movably arranged at an angle to" its camera, the rest of the appellants' specification

b. Obviousness Determination

"Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious." *Massingill*, at *3. The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently. . . ." *In re Zurko*, 258 F.3d 1379, 1383, 59 USPQ2d 1693, 1696 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, Baumgarten describes "a device and method for generating images of a computer user and the surrounding area behind the user and for transmitting these images to the user." (Col. 1, l. 66 - col. 2, l. 2.) More specifically, the "image generating

does not mention, let alone explain, the meaning of the movable arrangement. Giving it its broadest, reasonable construction, the limitation merely requires arranging a movable mirror at some angle to a camera.

device 4 comprises a base housing 20 mounted on a support 22 and a mirror 24 attached to one side of base housing 20." (Col. 3, ll. 29-31.) Because the device also includes "means for mounting a video camera 70 to the back of mirror 24," (col. 4, ll. 65-66), we agree with the examiner's finding that the reference teaches attaching a mirror to a camera.³

2. Transparent Area

The examiner finds, "Janow clearly teaches the advantageous [sic] of arranging of a transparent material in front of the camera in order to make the existence of hole being less apparent to a viewer (e.g. col. 5 lines 42-55), thereby making it less unsightly and making the displayed image more uniform. . . ." (Examiner's Answer at 16.)

The appellants allege, "the suggested desirability of modifying a mirror based on a disclosure of a lenticular structure projection screen in Janow finds absolutely no

³Baumgarten further explains that its "[h]ousing 20 is . . . pivotally mounted to upright member 26 (via, e.g., a swivel joint (not shown)) around both the longitudinal axis of the upright member 26 and around an axis perpendicular to member 26. This permits the user to pivot housing 20 and mirror 24 up and down and from side to side to change the viewing angle of the image reflected by mirror 24." (Col. 3, ll. 39-43). Because the reference's mirror can be pivoted, we find that Baumgarten teaches a movable mirror. Because the video camera is mounted to the back of the mirror, (col. 4, ll. 65-66), wherein the mounting necessarily occurs at some angle, moreover, we find that the reference teaches arranging the movable mirror at some angle to the camera.

disclosure, teaching, or motivation from the combination of references." (Appeal Br. at 9.)

a. Claim Construction

Claim 18 further recites in pertinent part the following limitations: "a two-way transparent center area" Giving the representative claim its broadest, reasonable construction, the limitations merely require a transparent area.

b. Obviousness Determination

"The presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact." *In re Gartside*, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). A suggestion to combine teachings from the prior art "may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved." *WMS Gaming Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999) (citing *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998)).

Here, "FIG. 5 [of Baumgarten] illustrates . . . [that] planar portion 36 of mirror 24 defines a hole 80 for allowing videocamera 70 to shoot directly through hole 80 to the user." (Col. 6, ll. 1-4.) For its part, "FIG. 7 [of Janow] shows a side view of . . . projection screen 105 in which transparent material 701 is positioned in hole 401." (Col. 5, ll. 50-52); "[t]ransparent material 701 may be a plug inserted into hole 401. . . ." (*Id.* at ll. 54-55.) Because the latter reference explains that, with the hole plugged by the transparent material, "[a]dvantageously, the projected image appears more uniform and the existence of hole 401 is less apparent to a viewer of the projected image," (*id.* at ll. 43-45), we agree with the examiner's finding that those skilled in the art would have been motivated to insert a transparent plug into Baumgarten's camera hole. Therefore, we affirm the rejection of claim 18 and of claims 1, 2, 4-7, 9-15, 19, and 20, which fall therewith, based on Baumgarten and Janow.⁴

The appellants do not separately argue the patentability of claims 3, 8, 16, or 17 but instead rely on their aforementioned arguments. Unpersuaded by these arguments, we also affirm the rejections of claims 3, 8, 16, and 17.

⁴ We consider Kamaya cumulative to the teachings of Baumgarten and Janow. The Board may rely on less than all of the references applied by an examiner in an obviousness rationale without designating it as a new ground of rejection. *In re Bush*, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961); *In re Boyer*, 363 F.2d 455, 458, n.2, 150 USPQ 441, 444, n.2 (CCPA 1966).

III. CONCLUSION

In summary, the rejections of claims 1-20 are affirmed.

"Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences. . . ." 37 C.F.R. § 1.192(a)(2004). Accordingly, our affirmance is based only on the arguments made in the briefs. Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.") No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

Joseph F. Ruggiero
JOSEPH F. RUGGIERO
Administrative Patent Judge

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